

### **REMARKS**

This is responsive to the non-final Office Action mailed September 23, 2008. Claims 1-26 and 40-47 are pending. Claims 1, 18, 21, 23, 25 and 47 are of independent format. Reconsideration and allowance are requested for at least the following reasons.

#### **35 U.S.C. § 103 Rejections**

Claims 1-26 and 40-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker et al., U.S. Patent No. 6,149,620 in view of Desai, U.S. Patent No. 5,395,312. Applicant respectfully disagrees with the rejections.

Claims 1, 18, 21, 23, 25, and 47 all recite an electrode tip having an electrically conductive cone shaped portion.

As shown in the Applicant's response of July 21, 2008, Baker et al. does not teach an electrode tip comprising an electrically conductive cone shaped portion. Desai is cited in the present Office Action for teaching a cone shaped electrode at Figure 4G. The Applicant respectfully disagrees.

Desai does not provide any three dimensional view of the operational end 32 shown in Figure 4G to illustrate the configuration of the operation end 32. Desai only provides what appears to be a side view. Consequently, one can not determine that the operational end 32 of Figure 4G is cone shaped when only a two dimensional representation is provided. Applicant believes the Examiner is reading the feature of an electrode tip having an electrically conductive cone shaped portion into Desai, which, as shown below, does not exist.

Desai teaches various embodiments for cutting tissue. See, for example, Figure 11, which shows, according to Desai, 3 different types of cutting tools. Col. 9, ll. 39-41. Consequently, it may be concluded that Desai's devices are intended to cut tissue. Consistent with this understanding of Desai, Applicant believes Figure 4G, taken in combination with Figures 4E, 4F, 4H and 4I, show various cutting tools with differing edges. For example, Figure 4E appears to show a single angled edge; Figure 4F appears to show a circular edge; Figure 4G appears to show two opposing angled edges; Figure 4H appears to show a tear drop edge; and Figure 4I appears to show a right-angle edge.

Moreover, the Applicant further believes the electrostatic probes in Figures 4E-4I to actually teach a blade shape, which is consistent with cutting tissue. This understanding of Desai appears to better explain why a three dimensional configuration of the operation end 32 was not provided by Desai. In other words, if the electrostatic probes have a similar profile, there would be little reason to show the profile for each probe as such is commonly understood.

Applicant further directs attention to the following passage of Desai:

The surgical instrument 20 also includes a port 31 which allows the surgeon to insert microsurgical instrumentation (not shown) along the access conduit 25 and the bore of the hollow probe 28 to exit from the end 32 thereof.

Col. 4, ll. 46-50 (emphasis added). In order for the microsurgical instrumentation to exit from end 32, there must be some opening at end 32 large enough for the microsurgical instrumentation to pass through. If the electrostatic probes 4E-4I are interpreted as being blade shaped, an opening may be provided along side the probe for the microsurgical instrument to pass. However, if the electrostatic probe of Figure 4G is cone shaped, the Applicant believes the opening at end 32 would be absent since the edge of the cone would have to fit with the bore of hollow probe 28.

Applicant believes the foregoing understanding to be more accurate of Desai, particularly as Desai discloses other embodiments for cutting tissue. Furthermore, Applicant believes it has clearly been shown that Desai does not teach an electrode tip extending distally beyond a distal end of a shaft comprising an electrically conductive cone shaped portion.

Reconsideration and allowance of claims 1-26 and 40-47 are respectfully requested.

**Summary**

In view of the above remarks, Applicant respectfully requests a Notice of Allowance. The Examiner is invited to telephone the undersigned at the below-listed number in order to facilitate advancement of the prosecution of this application.

Respectfully submitted,  
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